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Fort Collins, CO 80527-2400

EXAMINER

POPOVICI, DOV

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARCOS TERES

Appeal 2009-007107
Application 09/918,688
Technology Center 2600

Before ROBERT E. NAPPI, JOHN C. MARTIN,
and ELENI MANTIS MERCADER, *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON APPEAL¹

STATEMENT OF THE CASE

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

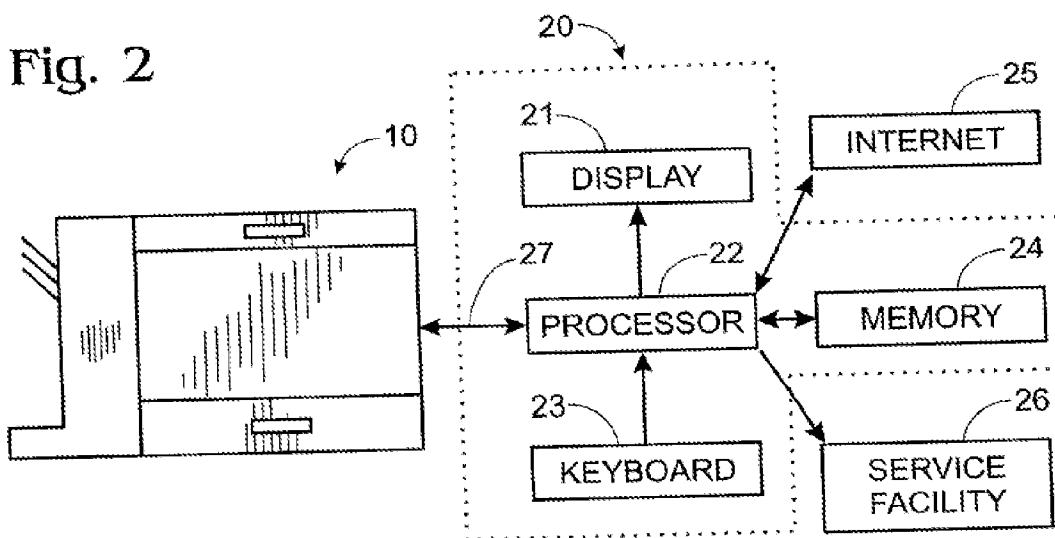
Appellant appeals under 35 U.S.C. § 134(a) from the non-final rejection of claims 1-7, 9-16, and 18-20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

INVENTION

Appellant's Figure 2 is reproduced below:

Fig. 2



Appellant's Figure 2 indicates a computer processor 22 connected to a printer system 10 and a printer service facility 26 (Spec. 3:30-4:3).

Appellant's claimed invention is directed to a system and a computer-assisted method for diagnosing a malfunction in the printer wherein the printer system 10 communicates one or more symptoms of the printer system malfunction to the processor 22. Processor 22 analyzes the symptoms, by comparing those symptoms with known printer system malfunctions stored in memory 24. By comparing the symptoms the processor 22 identifies the most appropriate malfunction that would produce the described symptoms and reports the malfunction. *See* Spec. 3-4.

Claim 1, reproduced below, is representative of the subject matter on appeal:

1. A computer-implemented method for diagnosing a malfunction in a printer system using a computer system comprising a processor, the method comprising the steps of:

communicating a present description of one or more symptoms of the printer system malfunction to the processor;

correlating the one or more symptoms with known printer system malfunctions, wherein correlating the one or more symptoms includes comparing the present description of the one or more symptoms to a database relating symptoms to known printer system malfunctions;

identifying a most appropriate malfunction that would produce the described symptoms; and

reporting the most appropriate malfunction, where reporting includes electronically transmitting a report.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Hamilton	US 5,200,958	Apr. 6, 1993
Maekawa	US 5,386,271	Jan. 31, 1995
Sawada	US 5,790,916	Aug. 4, 1998
Limori	US 5,949,553	Sep. 7, 1999

The following rejections are before us for review:

1. The Examiner rejected claims 1, 5-7, 9-13, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Maekawa.

2. The Examiner rejected claims 2-4, 14-16, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Maekawa in view of Hamilton.

ISSUE

The pivotal issue is whether the combination of Maekawa in view of Hamilton teaches the limitation of “electronically transmitting a report” as recited in representative claim 1.

FINDINGS OF FACT (FF)

The following Findings of Fact are supported by a preponderance of the evidence:

1. Appellant’s Specification explicitly describes that the variety of output methods include displaying the report on the monitor *or* electronically transmitting a report (Spec. 8, ll. 13-15).
2. Maekawa teaches that diagnosis of abnormal operating conditions of the copying machine may be displayed on display 92 (*see* col. 3, l. 43-col. 4, l. 2 and Abstract). Maekawa further states that a “fuzzy operation referring to knowledge base is implemented on the basis of the data and the like and conditions of copying machine, measures to be taken and possibilities are displayed” and that “[a]ccordingly, even a not well-experienced service man can obtain the best and specific instructions about adjustment, repair and the like, and can take appropriate measures quickly” (col. 16, ll. 34-42).
3. Sawada teaches (Figs. 6, 7, and col. 9, ll. 17-33) sending information electronically to a serviceman regarding a diagnosed problem, wherein the information is necessary for the service.

PRINCIPLES OF LAW

“The diversity of inventive pursuits and of modern technology counsels against confining the obviousness analysis by a formalistic

conception of the words teaching, suggestion, and motivation, or by overemphasizing the importance of published articles and the explicit content of issued patents.” *KSR Int’l Co., v. Teleflex Inc.*, 550 U.S. 398, 402 (2007). “Rigid preventative rules that deny factfinders recourse to common sense . . . are neither necessary . . . nor consistent with” our case law. *Id.* at 421.

ANALYSIS

Analysis with respect to the rejection of claims 1, 5-7, 9-13, 18, and 19

Appellant argues (Br. 6) that one of ordinary skill in the art, would not equate, as the Examiner did (Ans. 11), Maekawa’s display of information on a monitor as “electronically transmitting a report” as recited in claim 1. Appellant’s Specification explicitly describes that the variety of output methods include displaying the report on the monitor *or* electronically transmitting a report (FF 1). As such, Appellant argues (Br. 6-7) that the Examiner’s interpretation of equating the two types of output, i.e., monitoring and electronically transmitting, as over-reaching.

Appellant also argues that because in Maekawa the cause of trouble is displayed at a centralized control unit, there is no motivation to additionally electronically transmit a report as recited in independent claims 1 and 13 or electronically report it to a service technician, as recited in claims 13 and 19. Appellant further argues (Br. 8-9), with respect to claim 9, that Maekawa fails to disclose “electronic transmission of a report” or “electronic transmission of a report to a printer service facility,” and that the Examiner’s assertion that this is well within the knowledge of skilled artisans is not persuasive.

We note that while we agree with Appellant (Br. 6-7) that displaying information on a monitor does not equate to “electronically transmitting a report,” as recited in claim 1, we are not persuaded by Appellant’s argument (Br. 8-9) that it is not well within the knowledge of skilled artisans, to utilize “*electronic transmission of a report*” or “*electronic transmission of a report to a printer service facility*,” as argued with respect to claim 9 (emphasis added).

Maekawa teaches that diagnosis of abnormal operating conditions of the copying machine may be displayed on display 92 (FF 2). While Maekawa does not expressly teach electronically transmitting the diagnosis (i.e., e-mailing the report), we agree with the Examiner that “[t]he sending of report information from one location is well known in the art” and that “it would have been obvious to one of ordinary skill in the art at the time of the invention to have transferred the report to another location, such as a service facility” (Ans. 7).

The Supreme Court stated that rigid preventative rules that deny factfinders recourse to common sense are neither necessary nor consistent with our case law. *See KSR*, 550 U.S. at 421. As noted above, Maekawa states that “implemented on the basis of the data and the like and conditions of copying machine measures to be taken and possibilities are displayed” and that “[a]ccordingly, even a not well-experienced service man can obtain the best and specific instructions about adjustment, repair and the like, and can take appropriate measures quickly” (FF2). It is common sense to modify Maekawa to include transmission of the diagnosed malfunction at CPU 91 of the centralized control unit to another CPU located at a remote facility where the technician may be located. In other words, instead of

displaying the report only at monitor 92, it would be common sense to e-mail (i.e., electronically transmit) the report at another location where a technician is located.

Accordingly, we will affirm the Examiner's rejection of the dependent claim 9 and for similar reasons the rejection of claim 1, from which claim 1 depends, and thus, any specific response by the Examiner regarding claim 9 necessarily extends and applies to the broader claim 1 rejected under the same grounds of rejection. For similar reasons, we will affirm the rejections of claims 5-7, 10-13, 18, and 19.

Analysis with respect to the rejection of claims 2-4, 14-16, and 20
Appellant does not present any additional arguments with respect to claims 2-4, 14-16, and 20, and only asserts that Hamilton fails to cure the above cited deficiencies as articulated *supra*. Accordingly, for the same reasons as stated above we will also affirm the Examiner's rejection of these claims.

CONCLUSION

The combination of Maekawa in view of Hamilton teaches the limitation of "electronically transmitting a report" based on common sense.

ORDER

The decision of the Examiner to reject claims 1-7, 9-16, and 18-20 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

Appeal 2009-007107
Application 09/918,688

AFFIRMED

gvw

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